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EXAMINER

ROSEN, N

ART UNIT

PAPER NUMBER

2764

7

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Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/290,251

Applicant(s)
Nagal et al.

Examiner
Nicholas D. Rosen

Group Art Unit
2764



☒ Responsive to communication(s) filed on Mar 27, 2000

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claim

☒ Claim(s) 1-16 is/are pending in the application

Of the above, claim(s) _____ is/are withdrawn from consideration

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-16 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

— SEE OFFICE ACTION ON THE FOLLOWING PAGES —

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1. Claims 1-16 have been examined.

Claim Objections

2. Claim 4 is objected to because of the following informalities: In the third line of the amended claim, the word, if it qualifies as such, “reproducor” appears. This is presumably an error for “reproduction and/or”, as occurs in claims 1, 2, and 3, or perhaps for other, similar wording. Appropriate correction is required.

3. Claim 1 is objected to because of the following informalities: Claim 1 recites the limitation “information concerning copying permission superimposed on or imbedded in the video data and/or audio data” in lines 10-12, which does not quite correspond to the antecedent statement. Lines 4-7 refer to “video data and/or audio data being generated by superimposing information concerning copying permission on a digitized video signal and/or audio signal.” It would be preferable to be consistent in the use of “signal” and “data.” Appropriate correction is required.

- a. Claims 2-9 and 13-16 are objected to on essentially the same grounds as claim 1, because claims 2-8 and 13-16 have similar minor discrepancies, and claim 9 depends on claim 8.

4. Claim 10 is objected to because of the following informalities: Claim 10 recites the limitation “information concerning copying consent on a digitized video data and/or audio data” in lines 9-10, which does not quite correspond to the antecedent statement. Lines 4-7 refer to “video data and/or audio data being generated by superimposing information concerning copying consent on a digitized video signal or audio signal.” It would be preferable to be consistent in the

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use of “signal” and “data,” and also in the use of “or” vs. “and/or.” Appropriate correction is required.

5. Claim 12 is objected to because of the following informalities: Claim 12 recites the limitation “information concerning copying consent superimposed on the video data or audio data” in lines 11-12, which does not quite correspond to the antecedent statement. Lines 4-7 refer to “video data and/or audio data being generated by superimposing information concerning copying consent on a digitized video signal and/or audio signal.” It would be preferable to be consistent in the use of “signal” and “data,” and also in the use of “or” vs. “and/or.” Appropriate correction is required.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was

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made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(f) or (g) prior art under 35 U.S.C. 103(a).

8. Claim 1 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying permission on a digitized video signal and/or audio signal or embedding the information therein (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying permission superimposed on or embedded in the video data and/or audio data (column 18, lines 12-41); and a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a determining unit which determines whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium, but Omi et al. teach determining whether a medium is dedicated to reproduction or recording (column 8, lines 52-67). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and stopping reproduction in response to a result indicating that the medium

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is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

9. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying permission on a digitized video signal and/or audio signal or embedding the information therein (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying permission superimposed on or embedded in the video data and/or audio data (column 18, lines 12-41); an error correction unit which conducts error correction according to an added correction code (column 14, lines 46-51; note also column 13, lines 51-57); and a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a determining unit which determines whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium, but Omi et al. teach determining whether a medium is dedicated to reproduction or recording (column 8, lines 52-67). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and stopping reproduction in

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response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

a. Tozaki et al. do not expressly disclose destroying data, as opposed to merely stopping reproduction. However, if reproduction is stopped, then the data being played from the medium to be reproduced are destroyed, since data which are not being reproduced anywhere are destroyed. The original data on the medium to be reproduced are not destroyed in the system of Tozaki et al., but neither does the instant application disclose destroying the original copies of such data.

10. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Claim 3 largely recites the same limitations as claim 2, and is therefore rejected on the same grounds. Claim 3 additionally recites that the destroying unit destroys data so as to make error detection of data not yet subjected to error correction processing possible and make error correction thereof impossible to certain indications. Tozaki et al. do not expressly disclose these limitations. However, when data is destroyed, error correction thereof becomes impossible; when data is not destroyed, error detection and correction by well-known techniques, as disclosed in Tozaki et al., may remain possible. Hence, the apparatus of claim 3 is held not to differ substantially from that of claim 2.

11. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having

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video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a digitized video signal and/or audio signal (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 21, lines 14-27); and an output unit which outputs data representing a reason of stoppage (column 21, lines 14-27). Tozaki et al. do not disclose an identifying unit which identifies whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium, but Omi et al. teach determining whether a medium is dedicated to reproduction or recording (column 8, lines 52-67). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include an identifying unit which identifies whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

a. Tozaki et al. do not expressly disclose that the means for notifying a user of the reason for stoppage outputs video data and/or audio data. However, official notice is taken that it is well known to convey information by video data (e.g., written words on a screen, diagrams, and other symbols) and by audio (e.g., spoken, recorded, or generated words, as well as buzzer sounds,

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etc.). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to output the notification as video data and/or audio data, for the obvious advantage of conveniently conveying the notification information.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a digitized video signal and/or audio signal (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); an error correction unit which conducts error correction according to an added correction code (column 14, lines 46-51; note also column 13, lines 51-57); and a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose an identifying unit which identifies whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium, but Omi et al. teach determining whether a medium is dedicated to reproduction or recording (column 8, lines 52-67). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a

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recordable medium, and stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

a. Tozaki et al. do not expressly disclose destroying data, as opposed to merely stopping reproduction. However, if reproduction is stopped, then the data being played from the medium to be reproduced are destroyed, since data which are not being reproduced anywhere are destroyed. The original data on the medium to be reproduced are not destroyed in the system of Tozaki et al., but neither does the instant application disclose destroying the original copies of such data.

b. Tozaki et al. do not expressly disclose that the destroying unit destroys data so as to make error detection of data not yet subjected to error correction processing possible and make error correction thereof impossible to certain indications. However, when data is destroyed, error correction thereof becomes impossible; when data is not destroyed, error detection and correction by well-known techniques, as disclosed in Tozaki et al., may remain possible.

c. Tozaki et al. do not expressly disclose that the means for notifying a user of the reason for stoppage outputs video data and/or audio data. However, official notice is taken that it is well known to convey information by video data (e.g., written words on a screen, diagrams, and other symbols) and by audio (e.g., spoken, recorded, or generated words, as well as buzzer sounds, etc.). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at

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the time of applicant's invention to output the notification as video data and/or audio data, for the obvious advantage of conveniently conveying the notification information.

13. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a digitized video signal and/or audio signal (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); and a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a determining unit which determines whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium, but Omi et al. teach determining whether a medium is dedicated to reproduction or recording (column 8, lines 52-67). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

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a. Tozaki et al. do not expressly disclose that the means for notifying a user of the reason for stoppage outputs a control signal, the control signal instructing a video signal and/or audio signal representing a reason of stoppage to be outputted. However, official notice is taken that it is well known to convey information by video data (e.g., written words on a screen, diagrams, and other symbols) and by audio (e.g., spoken, recorded, or generated words, as well as buzzer sounds, etc.). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to output a control signal instructing a video signal and/or audio signal representing a reason of stoppage to be outputted, for the obvious advantage of conveniently conveying the notification information.

14. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a digitized video signal and/or audio signal (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproducing unit which reproduces the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); an error correction unit which conducts error correction according to an added correction code (column 14, lines 46-51; note also column 13, lines 51-57); and a stopping unit which stops reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted

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(column 21, lines 14-27). Tozaki et al. do not disclose a determining unit which determines whether the medium to be reproduced is a medium dedicated to reproduction or a recordable medium, but Omi et al. teach determining whether a medium is dedicated to reproduction or recording (column 8, lines 52-67). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a determining unit which determines whether a medium to be reproduced is a medium dedicated to reproduction or a recordable medium, and stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information. ***

a. Tozaki et al. do not expressly disclose destroying data, as opposed to merely stopping reproduction. However, if reproduction is stopped, then the data being played from the medium to be reproduced are destroyed, since data which are not being reproduced anywhere are destroyed. The original data on the medium to be reproduced are not destroyed in the system of Tozaki et al., but neither does the instant application disclose destroying the original copies of such data.

b. Tozaki et al. do not expressly disclose that the destroying unit destroys data so as to make error detection of data not yet subjected to error correction processing possible and make error correction thereof impossible to certain indications. However, when data is destroyed, error correction thereof becomes impossible; when data is not destroyed, error detection and correction by well-known techniques, as disclosed in Tozaki et al., may remain possible.

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c. Tozaki et al. do not expressly disclose an output unit which outputs a control signal instructing video data and/or audio data representing a reason why reproduction is impossible to be outputted. However, official notice is taken that it is well known to convey information by video data (e.g., written words on a screen, diagrams, and other symbols) and by audio (e.g., spoken, recorded, or generated words, as well as buzzer sounds, etc.). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to output the notification as video data and/or audio data, for the obvious advantage of conveniently conveying the notification information.

15. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Takemura et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a digitized video signal and/or audio signal (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a permission information reproduction circuit reproducing the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); and a reproduction stopping circuit stopping reproduction in response to the information reproduced by the reproducing unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not expressly disclose a medium identification code detection circuit detecting the medium identification code, but Takemura et al. teach detecting a medium identification code

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(column 9, lines 14-20). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a medium identification code detecting circuit detecting the medium identification code, and to stop reproduction in response to a medium identifying code indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

16. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. and Takemura et al. as applied to claim 8 above. Tozaki does not disclose integrating a medium identification detecting circuit and a reproduction stopping circuit into a single semiconductor device, but official notice is taken that it is well known to integrate a multiplicity of circuits into a single semiconductor device (as witness the terms "integrated circuit" and "computer on a chip"). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to integrate these several circuits into a single semiconductor device, for the obvious advantages of simplifying chip manufacture, not needing to connect a multiplicity of chips to one another, and enhanced security, in that signals within a single chip cannot be as readily detected and falsified as signals between separate chips or other arrangements of circuit elements.

17. Claim 10 rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Doi. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by

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superimposing information concerning copying consent on a digitized video signal or audio signal (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproduction unit for reproducing the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); and a stopping unit for stopping reproduction in response to the information reproduced by the reproduction unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a detection unit for detecting reflectance of a disk, or a determining unit for determining whether the disk is a recordable medium or a medium dedicated to reproduction on the basis of the reflectance of the disk, but Doi teaches determining whether a disk is dedicated to reproduction or recording, based on the reflectance of the disk (column 13, lines 46-55). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a detection unit for detecting reflectance of a disk, and a determining unit which determines whether a disk is a recordable medium or a medium dedicated to reproduction, and stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

18. Claim 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Doi and in view of Takemura et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction and/or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying consent on a

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digitized video signal or audio signal (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproduction unit for reproducing the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); and a stopping unit for stopping reproduction in response to the information reproduced by the reproduction unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a reflectance detection unit for detecting reflectance of a disk, or a determining unit for determining whether the disk is a recordable medium or a medium dedicated to reproduction on the basis of the reflectance of the disk, but Doi teaches determining whether a disk is dedicated to reproduction or recording, based on the reflectance of the disk (column 13, lines 46-55). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a reflectance detection unit for detecting reflectance of a disk, and a determining unit which determines whether a disk is a recordable medium or a medium dedicated to reproduction, and stopping reproduction in response to a result indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

a. Tozaki et al. do not expressly disclose an identification detection unit for detecting the medium identification code, but Takemura et al. teach detecting a medium identification code (column 9, lines 14-20). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include an identification code detecting unit for detecting the medium identification code, and to stop reproduction in response to a medium

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identifying code indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

19. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Yokota et al., and of Fox. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying permission on a digitized video signal and/or audio signal or embedding the (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproduction unit which reproduces the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); and a stopping unit which stops reproduction in response to the information reproduced by the reproduction unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a wobble detection unit for detecting wobbled grooves existing on a disk, but Yokota et al. teach such a wobble detection unit (column 3, lines 43-55). Furthermore, Fox explicitly teaches preventing piracy by a system which rejects disks for copying if they lack wobbled grooves (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a wobble detection unit for detecting wobbled grooves, and to stop reproduction if the wobble detecting unit does not detect wobbled grooves, for the obvious advantage of limiting the reproduction of proprietary information.

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20. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Yokota et al., Fox, and Takemura et al. Tozaki et al. disclose a reproduction apparatus for reproducing video data and/or audio data from a medium dedicated to reproduction or a recordable medium having video data and/or audio data recorded thereon, said video data and/or audio data being generated by superimposing information concerning copying permission on a digitized video signal and/or audio signal or embedding the (Abstract; see also column 1, lines 38-48), said reproduction apparatus comprising: a reproduction unit which reproduces the information concerning copying consent superimposed on the video data and/or audio data (column 18, lines 12-41); and a stopping unit which stops reproduction in response to the information reproduced by the reproduction unit indicating that copying once was permitted (column 21, lines 14-27). Tozaki et al. do not disclose a wobble detection unit for detecting wobbled grooves existing on a disk, but Yokota et al. teach such a wobble detection unit (column 3, lines 43-55). Furthermore, Fox explicitly teaches preventing piracy by a system which rejects disks for copying if they lack wobbled grooves (Abstract). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include a wobble detection unit for detecting wobbled grooves, and to stop reproduction if the wobble detecting unit does not detect wobbled grooves, for the obvious advantage of limiting the reproduction of proprietary information.

a. Tozaki et al. do not expressly disclose an identification unit for detecting the medium identification code, but Takemura et al. teach detecting a medium identification code (column 9,

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lines 14-20). Hence, it would have been obvious to one of ordinary skill in the art of copy protection at the time of applicant's invention to include an identification code detecting unit for detecting the medium identification code, and to stop reproduction in response to a medium identifying code indicating that the medium is a medium dedicated to reproduction, for the obvious advantage of limiting the reproduction of proprietary information.

21. Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Claim 14 recites a method of doing what claim 1 recites apparatus for doing; therefore, claim 14 is rejected on the same grounds as claim 1. (Examiner does not believe the distinction between permission and consent to be of any importance in this context.)

22. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Claim 15 recites a method of doing what claim 2 recites apparatus for doing; therefore, claim 15 is rejected on the same grounds as claim 2. A slight complication is that claim 15 additionally recites "simultaneously judging error correction to be impossible," which claim 2 does not. However, if data is being destroyed altogether, as recited in claims 2 and 15, error correction is held to be inherently impossible, or at least pointless. One cannot correct data which does not exist.

23. Claim 16 is rejected under 35 U.S.C. 103(a) as being unpatentable over Tozaki et al. in view of Omi et al. Claim 16 recites a program for doing what claim 1 recites apparatus for doing; therefore, claim 16 is rejected on the same grounds as claim 1. (Examiner does not believe the distinction between permission and consent to be of any importance in this context.)

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Response to Arguments

24. Applicant's arguments filed March 27, 2000, have been fully considered but they are not persuasive.

25. Applicant's arguments with respect to claims 1, 2, 3, 4, 5, 6, 7, 12, 13, 14, 15, and 16 have been considered but are moot in view of the new ground(s) of rejection. Applicant argues that Tozaki et al. do not disclose all limitations of claims 1, 2, 4, 6, 14, and 15; Examiner now cites other art in combination with Tozaki et al., and holds those claims to be obvious (not, as held by a colleague of Examiner in the first Office action, anticipated). Applicant argues that Kuroda does not make up the deficiencies of Tozaki et al. with regard to claims 3, 5, 7, and 15; Examiner now rejects these claims as unpatentable over Tozaki et al. in view of Omi et al. Applicant argues that Yokota et al. do not overcome the deficiencies of Tozaki et al. with regard to claims 12 and 13; Examiner now rejects these claims as unpatentable on the additional ground provided by Fox. Fox expressly teaches preventing piracy by a system which rejects disks for copying if they lack wobbled grooves.

With regard to claims 8, 9, 11, and 13, Applicant argues that Takemura et al. do not overcome the deficiencies of Tozaki et al. Applicant argues that Takemura merely discloses forming an identification signal of a disk, without using such an identification signal for the purposes of the present invention. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where

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there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is held that one of ordinary skill in the art of copy protection would be motivated to use disk identification, such as Takemura et al. teach, for the goal of helping to distinguish disks which may properly be duplicated from disks which may not be. Accomplishing this objective is a well known concern of the music industry, as is taught, for example, by Parker, Johnstone, and Starrett.

With regard to claim 10 and 11, Applicant argues that Doi does not overcome the deficiencies of Tozaki et al. Applicant argues that Doi merely discloses distinguishing different types of disk by their reflectance, without a determining unit for determining whether the disk is a recordable medium or a medium dedicated to reproduction on the basis of the reflectance of the disk, or a stopping unit which stops reproduction in response to an indication that the medium is a medium dedicated to reproduction. In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, it is held that one of ordinary skill in the art of

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copy protection would be motivated to use disk reflectance to determine whether a disk is a recordable medium, for the goal of helping to distinguish disks which may properly be copied from disks which may not be. First, Doi definitely does disclose a determining unit for determining the type of a disk; this is the main thrust of his invention, although Doi's purpose is to determine how much laser light to expose a disk to, rather than whether it is lawful and ethical to copy from that disk. Doi does not disclose a stopping unit for stopping copying from a disk in response to an indication that the disk is a medium dedicated to reproduction, but Tozaki et al. disclose the stopping unit, and it is held that one of ordinary skill in the art would be motivated to use information gathered from a reflectance determining unit like that disclosed by Doi, for the goal of helping to distinguish disks which may properly be duplicated from disks which may not be. Accomplishing this objective is a well known concern of the music industry, as is taught, for example, by Parker, Johnstone, and Starrett.

Conclusion

26. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Yagasaki et al. (U.S. Patent 5,991,499) disclose a data recording apparatus and method for preventing illegal copying. Park (U.S. Patent 6,028,932) discloses a copy prevention method and apparatus for digital video systems. Ichimura et al. (U.S. Patent 6,034,832) discloses a recording medium having digital copy management recorded therein, and apparatus in which reproduction is controlled in accordance with the digital copy management data. Kori (U.S.

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Patent 6,035,094) discloses a video signal processing apparatus and method for copy protection. Wachi (U.S. Patent 6,038,207) discloses an optical disk whose use can be inhibited based on its reflectance. Uesaka et al. (U.S. Patent 6,044,157) disclose a microprocessor suitable for reproducing audiovisual data while preventing illicit reproduction.

a.Sugiyama et al. (European Patent Application 0 718 840 A2) disclose a data recording medium and apparatus with provisions for inhibiting the copying of unauthorized audiovisual data. Sugiyama discloses a similar system in Japanese document 8-180604 A.

b.Parker's article, "DVD Copy Protection: An Agreement at Last?" discusses technical and political issues related to DVD copy protection. Johnstone's article, "Year of Listening Digitally," discusses copy protection, and in particular refers to a mechanism for enabling users to make first generation copies, but not second generation copies. Starrett, "Going Gold with Music," also discloses the prevention of making multiple copies. The Microsoft Press Computer Dictionary includes a definition of "integrated circuit," disclosing that the integration of multiple circuits on one chip is well known.

27. Any inquiry concerning this communication or earlier communications from the examiner should be addressed to Nicholas D. Rosen, whose telephone number is (703) 305-0753. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner are unsuccessful, the examiner's supervisor, James Trammell, can be reached at (703) 305-9768. The fax number for this Group is (703) 308-1396.

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Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to Nicholas.Rosen@uspto.gov.

All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark Office on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist, whose telephone number is (703) 305-3900.

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May 31, 2000


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